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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) P1917 US00	
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	First Named Inventor ANDERSON, GLEN J.	
	Art Unit 2134	Examiner JUNG, DAVID Y.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
     Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.   **35,987**
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

_____ Signature

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Aug. 6, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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AUG 0 6 2008   Docket No. P1917US00
                                      Attorney's Docket No. 32654

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No. 10/624,857   )
First Named Applicant: GLEN J. ANDERSON   )
Filed: July 22, 2003   )
For: DIAGNOSTIC AUTHENTICATION CODES   )
)
TC/A.U.: 2134   )
Examiner: David Yiuk Jung   )

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

MEMO IN SUPPORT OF

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In connection with the Notice of Appeal and Request for Pre-Appeal Brief Request for Review, the following discussion is submitted to support the Request.

Initially, claims 18 through 29 of the application will be considered. The rejection of the final Office Action did not specifically address the requirements of these claims, other than a single sentence appended to the text of the rejection of claim 17 that asserted that "[r]egarding claims 18-29, such particular features are well known in the art for the purpose of security".

Firstly, the assertion of "well known in the art" was timely challenged in the response to the final Office Action, and the following discussion will focus on the distinctions between the requirements of the claims and the cited art. It is submitted that the cited Burstein ands DRM documents do not disclose these features, and in some cases, the requirements of the claims are contrary to what is actually discussed in the documents.

Secondly, the mere assertion that the features of claims 18 through 29 are "well known in the art for the purpose of security", even if it could be shown to be true, does not establish the non-patentability of the claims as it does not establish the "obviousness" of the combination of these allegedly "well known" with the cited Burstein and DRM

documents. The rejection does not even assert that the combination of these allegedly "well-known" features with the cited Burstein and DRM documents is obvious.

More specifically, consider claim 26, which requires that "the authenticating code is generated *without user intervention*". This requirement is contrary to the discussion in the cited portion of the Burstein patent at col. 10, lines 24 through 37 that indicates the operator supplies the "authentication information" (all emphasis added):

> Referring to FIG. 2, a start screen generated by the front-end domain manager is illustrated. In this illustrative implementation, it is assumed that the operator accessing the domain manager is acting as an agent for a domain name registrant to modify some information about the domain name or perform another domain management function. Such a start screen preferably requests identification and authentication information *from the operator* to ensure that *the agent is authorized* to use the domain manager and to make changes for that domain.

It is submitted that one of ordinary skill in the art , considering the Burstein patent would recognize that the operator provides the authentication information, and thus Burstein does not disclose that ""the authenticating code is generated without user intervention".

Further, claim 27 requires that "the authentication code is *generated by* the computer system", which, for the reasons set forth above, is contrary to Burstein's requirement that the operator supply the "authentication information" to the domain manager of the Burstein system.

Still further, claim 24 requires that "the authentication code generated *is unique to the diagnostic code* received", which is contrary to the discussion in Burstein patent that tells one of ordinary skill in the art that the "authentication information" of Burstein is assigned to the operator and the operator uses the same "authentication information" at each log in. This indicates that the Burstein system would always utilize the same "authentication information" for the operator so that the operator would always be recognized as "authoritative". This is contrary to the requirements o claim 24.

Claim 25 requires that "a user is incapable of generating the authentication code", and it is submitted that the "identification and authentication information from the operator" relied upon in the rejection does not lead one of ordinary skill in the art to a code that a user is incapable of generating.

Claim 23 requires that "the generating of the authentication code is performed *after the receiving of the diagnostic code*", and this is in conflict with the discussion in

Burstein quoted above in which the operator supplies the "authentication information" in order to log in to the Burstein system to perform any functions. Thus, the "authentication information" would be supplied by the operator *prior to* any receipt of a diagnostic code, rather than generating the authentication code after receiving the diagnostic code as required by claim 23.

Claim 28 requires "requesting an authentication code by the computer system *after* receiving the diagnostic code" and claim 29 requires that "generating the authentication code is *performed in response to* receiving the diagnostic code", which is completely opposite of the apparent order of operations set forth in the Burstein patent, for the reasons set forth above with respect to claim 23.

Claim 17 requires that "generating the authentication code comprises encoding a serial number into the authentication code". As noted above, the "authentication information" of the Burstein patent that is relied upon in the rejection is provided to and used by a particular operator to identify and authenticate him or her to the system, and it has not been established in the rejection why one of ordinary skill in the art would encode a serial number in an operator's authentication information, or why, as required by claim 18, "a computer system serial number" would be encoded into the operator's "authentication information", or why, as required by claim 19, "a serial number for a hardware component of a computer system" would be encoded into the operator's "authentication information".

The rejection further cites the Burstein patent at col. 14, line 61 through col. 15, line 67, but nothing there discloses the *origin* of the authentication information or that the authentication information is associated with a diagnostic code, or that any authenticating code is generated in response to the reception of a diagnostic code, or that the "authentication information" is unique to the diagnostic code.

In summary, it is submitted that the rejection of claims 18 through 29 does not state a prima facie case of obviousness.

As previously pointed out, the Burstein patent describes an authentication process that is performed and completed prior to any further communication. Note that Burstein says that "[o]nce logged in or otherwise authenticated through a screen like that illustrated in FIG. 2, [then] a screen such as that illustrated in FIG. 3 appears to prompt

for the domain name to be modified or managed by the operator" (implied word inserted). There is no suggestion that the authentication information that is received as a part of the initial authentication process is associated with anything that might be interpreted by one of ordinary skill in the art as a diagnostic code. Instead, the Burstein patent discusses encryption of the subsequent communications rather than any authentication associated with any diagnostic codes. It is therefore submitted that there is no association between the authentication process which occurs initially and independently of the further operations.

It is submitted that Burstein does not disclose what it is alleged to disclose for the simple fact that Burstein discusses authentication information for a person ("operator" or "agent"), and not for anything meeting any of the alternatives discussed for a "diagnostic code", and clearly Burstein does not establish that the "authentication information" provided by the operator is in any way "generat[ed]... for the *generated* diagnostic code" as required by claims 1, 9, and 15.

Moreover, the language of the claims does not merely recite adjectives for the codes, but includes substantive requirements that do not appear to have been considered here. See, especially, claim 15 which requires "receiving a diagnostic code generated by a computer system for a component of the computer system", "generating an authentication code *in response to* receiving the diagnostic code", and "associating the authentication code with the diagnostic code." Clearly, the causal requirements set forth in claim 15 are not met by the allegedly obvious combination of DRM and Burstein.

Withdrawal of the §103(a) rejection of claims 1 through 29 is therefore respectfully requested.

Respectfully submitted,

GATEWAY, INC.

By _____   Date: _Aug. 6, 2008_
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